



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,667	09/26/2001	Mark Thompson	020375-003500US	2848

20350 7590 06/02/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,667

Applicant(s)

THOMPSON, MARK

Examiner

JAGDISH N PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3624

DETAILED ACTION

1. This communication is in response to amendment filed 4/29/03.

Response to Amendment

2. Claims 1-3, 7, 9-13, 18 and 23 have been amended, claim 8 has been canceled per request. Claim 1-7 and 9-24 remain pending.

3. Rejection of claims 1-12 under 35 USC § 101 have been withdrawn.

Response to Arguments

4. Applicant's argument that the references fail to teach "collection of the cost from the customer at one of the plurality of provider offices" is not convincing. As explained in the following paragraphs, Lai discloses that the provider computer ("agent's company website 12", Fig. 9 para [0036]) records collection of the cost (escrow account is maintained by the agent, para [0036]) from the customer. Furthermore, Lai teaches that the provider computer ("agent's company website 12") is affiliated with a plurality of provider offices (merchant websites 125 from which the consumer selects an item for purchase are associated with the agent's company web site 12 para [0036]). Since, the purchases are made at the merchant websites, it is inherent that

Art Unit: 3624

provider computer (agent's company web site 12) records the collection of cost from the customer at one of the plurality of provider offices in accordance with the communication relating to the transaction (refer to transaction as discussed in para [0036]).

For the reasons stated in above analysis, the examiner asserts that the arguments forwarded by the applicant are not persuasive.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 and 9-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Exemplary analysis: claim 1, in line 3 recites "a provider computer affiliated with a plurality of provider offices". Furthermore, claim 1, in line 6, limitation recites "recording by the provider computer, collection of cost from the customer at one of the plurality of provider offices..".

Art Unit: 3624

6. It is unclear how the provider computer (a computing device) may be affiliated with a plurality of (provider) offices as the offices are not devices which are in communication with the computer. In this regard, no patentable weight is accorded to limitation "affiliated with a plurality of provider offices". This is also because scope of the claim is not affected by affiliation of the provider computer with a plurality of provider offices. Likewise, scope of "recording by the provider computer" step is not affected by where the customer is located. Therefore, "recording ... collection of the cost from the customer at one of the plurality of offices .." is interpreted to read "recording ... collection of the cost from the customer.."

This analysis also applies to independent claims 13 and 23.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the

Art Unit: 3624

United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-7, 9-11, 13-19, 23 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lai (Pub. No.: US 2001/0037290) (hereafter Lai).

Claim 1: Lai discloses a method for managing a transaction for a sale of goods between a customer and a merchant (abstract), the method comprising:

Receiving by a provider computer .. a communication relating to the transaction that includes a cost of the goods (provider is a company agent 12, who receives the transaction information from the merchant's web site(s) 125, see para [0036]);

Recording, by the provider computer, collection of the cost from the customer at one of the plurality of provider offices in accordance with the communication (escrow payment received from the customer, see para [0036]);

Authorizing payment, by the provider computer, of the cost to the merchant after the merchant delivers the goods (the agent..then sends ..for transfer of payment.. see para [0037]).

Claim 2: recording collection of the cost from the customer comprises recording collection of an entirety of the cost of goods plus a service charge before the merchant delivers the goods (Lai, inherent because the transaction process involves shipping the goods and it customary practice to add cost of goods in the transaction cost, para [0037]).

Art Unit: 3624

Claim 3: recording collection of a portion of the cost plus service charge ..and recording collection of a reminder of the cost plus service charge ..(although not explicitly recited in the applied references, it is an obvious and customary practice in sales to provide for alternate payment arrangements by the merchants to the customers and therefore inherent in Lai reference).

Claim 4-5: customer and merchant are located in a different country (Lai provides for both the customers and the merchants (partners) have access of the system via the Internet which reaches all users in the world, therefore this limitation is inherent, Fig. 1 and 2).

Claim 6: ..goods are delivered to.. by the merchant (Lai para [0037], shipping the goods from the designated merchant warehouse 148).

Claim 7: ..goods are delivered by the merchant to one of the one of plurality of provider offices (p. 5, para [0037] inherent to Lai reference because, this limitation is a customary practice of delivering goods to the customer at the point of purchase upon the customer's request (i.e. at the merchant's store (alternatively the merchant's web site 12)).

Claim 9-10: ..authorizing, by the provider computer, release of the goods to the customer after recording collection of the cost (col. 5 [0037] refer to discussion

Art Unit: 3624

of claim 1 wherein the agent collects the cost from the customer in escrow account held by the "agent", and subsequently releases the goods, also a customary and well known practice of escrow).

Claims 10 recites further extension of the escrow account 136 and is similarly analyzed.

Claim 11: providing a hyperlink to a web site of the merchant (Fig. 1, website's server host 82 as referenced in para [0026]).

Claim 13 and 23 are analyzed as per corresponding method claim 1 which recite corresponding limitations.

Claim 14: refer to claim 5 analyses.

Claim 15: refer to claim 11 analyses.

Claim 16: refer to claim 3 analyses.

Claim 17: refer to claim 2 analyses.

Claim 18: refer to claims 7-10 analysis.

Claim 19: refer to claim 3 analyses.

Claim 24: refer to claim 5 analyses.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

Art Unit: 3624

are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 12 and 20-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Lai.

Claim 12: Lai fails to teach determining by the provider computer, a shipment of the goods as part of an aggregate shipment.

Official is notice is taken that aggregating goods for shipment is old and well known business practice. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement this process because aggregating goods (such as according to geographic address of the customer etc.) would reduce cost of shipment and improve logistics of the transport process.

Claims 20 and 21: Lai fails to teach service charge and currency exchange as recited.

Official is notice is taken that including shipping and insurance cost to the service charge and further performing currency transaction are old and well known business practices in sales and specifically in e-commerce transactions. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement these features as desired and needed by the merchant.

Claim 22: refer to claim 12 analyses.

Art Unit: 3624

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

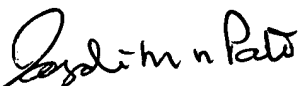
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official

Art Unit: 3624

faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.


Jagdish N. Patel

(Examiner, AU 3624)

5/29/03